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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,508	02/05/2004	Richard S. Ginn	704117.4012	6546

34313 7590 07/25/2007  
ORRICK, HERRINGTON & SUTCLIFFE, LLP  
IP PROSECUTION DEPARTMENT  
4 PARK PLAZA  
SUITE 1600  
IRVINE, CA 92614-2558

EXAMINER
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SCHILLINGER, ANN M

ART UNIT	PAPER NUMBER
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3738

MAIL DATE	DELIVERY MODE
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07/25/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

ED

**Office Action Summary**

Application No.

10/773,508

Applicant(s)

GINN, RICHARD S.

Examiner

Ann Schillinger

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2 and 4-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION*****Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2, 4, and 9-18 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 6,736,815 in view of Kuslich (U.S. Pat. No. 6,712,853). Regarding claim 1, claims 1, 2, 4, and 5 of patent '815 read disclose all of the limitations of claim 1 of the Application, except for securing ends of the band together. Kuslich teaches this in col. 13, lines 1-15 for the purpose of securing the band. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to tie the band ends together in order to secure it.

Claims 6, 10, 4, 4, and 5 of patent '815 read on claims 2, 4, 16, 17, and 18 of the Application, respectively. And claims 2 and 3 of patent '815 read on claim 15 of the Application. Although the conflicting claims are not identical, they are not patentably distinct

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from each other because both sets of claims address the same general method for treating the spinal region of a patient.

Regarding claims 9 and 12-14, the claims of U.S. Patent No. 6,736,815 probably do not disclose using additional material such as electrical energy on the spinal disc. Kuslich teaches this in col. 12 for the purpose of stimulating bone growth. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use additional material such as electrical energy on the spinal disc in order to stimulate bone growth.

Regarding claims 10 and 11, the claims of U.S. Patent No. 6,736,815 probably do not disclose using a nonporous or bioabsorbable material to comprise the band. Kuslich teaches this in col. 9, lines 15-36, for the purpose of utilizing the nonporous material's strength and the bioabsorbable material's compatibility with the patient's body. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use these materials in order to take advantage of their strength and absorbency.

Claims 5 and 6 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 6,736,815 in view of Kuslich in further view of Schneiderman (U.S. Pub. No. 2003/0032965). The claims of U.S. Patent No. 6,736,815 probably do not disclose the use of a fork member to adjust the vertebrae. Schneiderman teaches such a method, described in claims 5 and 6 as follows: the method of claim 4, wherein the adjusting step comprises: engaging at least one of the vertebrae between tines (106, 108, 116) of a fork member (100); and manipulating the tines between the vertebrae to increase a space between the vertebrae; and the method of claim 4, wherein the adjusting step comprises subjecting the patient to traction (paragraph 0043). Therefore, it would have been

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obvious to one of ordinary skill in the art at the time the invention was made to use this fork member to more easily insert the band into the vertebral region.

Claims 7 and 8 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 6,736,815 in view of Kuslich in further view of Belef et al. (U.S. Pub. No. 2002/0147497). Regarding claims 7 and 8, the claims of U.S. Patent No. 6,736,815 probably do not disclose the use of extra-cellular matrix material. Belef et al. teaches the use of this material in paragraph 0013 for the purpose of promoting bone growth and healing. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use extra-cellular matrix material as the fill material of the band to promote bone growth and healing in the patient.

#### *Response to Arguments*

In view of the amendments to the specification submitted 5/14/2007, the objections to the drawings detailed in the office action of 11/14/2006 are withdrawn.

Applicant's arguments with respect to claims 1-4 and 9-18 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments filed 5/14/2007 have been fully considered but they are not persuasive. Regarding claims 5 and 6 the Applicant contends that the fork member of the Schneiderman reference does not meet the limitations of the fork member of the Application. However, the claim language in claims 5 and 6 describes only that the fork member engage, manipulate, and provide traction on the vertebrae. As these claims are subject to the broadest, reasonable interpretation, the Schneiderman reference meets these broad limitations.

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Please see above and paragraphs 0041-0046 of the Schneiderman reference for further clarification.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ann Schillinger whose telephone number is (571) 272-6652. The examiner can normally be reached on Mon. thru Fri. 9 a.m. to 4 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ann Schillinger  
July 19, 2007

*A. Stewart*  
**ALVIN J. STEWART**  
**PRIMARY EXAMINER**